

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF:

JONATHAN EDWARD LIGHTNER
JOHN JOSEPH OKULEY

CASE NO.: BB-1043 US NA DIV

SERIAL NO.: UNKNOWN

GROUP ART UNIT: UNKNOWN

FILED: October 26, 2000

EXAMINER: UNKNOWN

FOR: GENES FOR MICROSOMAL DELTA-12
FATTY ACID DESATURASES AND
RELATED ENZYMES FROM PLANTS

Date: October 26, 2000

Asst. Commissioner for Patents
Washington, D.C. 20231

Sir:

INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. 1.97 AND 1.98

Pursuant to the duty of disclosure as set forth in 37 C.F.R. 1.56, the Applicant(s) would like to bring to the attention of the U.S. Patent and Trademark Office information that may be helpful in the examination of the above-identified patent application. All of the information is listed on an attached Form PTO-1449.

In this regard, benefit of the earlier filing dates of pending U.S. patent application number 09/133,962 filed August 14, 1998 which is a continuation of U.S. patent application number 08/262,401 filed June 20, 1994, which is a national filing continuation-in-part of pending PCT/US93/09987, filed October 15, 1993, which is a continuation-in-part of 07/977,339, filed November 17, 1992, now abandoned are claimed under 35 USC 120 for the captioned application. Thus, information cited in the priority applications is not supplied with this Information Disclosure Statement. See 37 CFR 1.98(d).

Pursuant to 37 CFR §1.56 the following is brought to the attention of the United States Patent and Trademark Office in connection with the above-identified application.

As is noted above, the instant application is entitled to the benefit of the earlier aforementioned filing dates. The instant application is the fourth in a series of cases.

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The first application bore Application No. 07/977,339 and was filed on November 15, 1992 and is now abandoned. This first application initially named Dr. Naren Yadav, a DuPont employee, and Dr. Jonathan Lightner as co-inventors. At the time this first application was filed, Dr. Lightner was a graduate researcher at Washington State University ("WSU"). Currently, Dr. Lightner is an employee of E. I. du Pont de Nemours and Company ("DuPont"). The inventorship of this first application was then corrected to add Dr. John Okuley as a co-inventor and to delete Dr. Yadav as a co-inventor. Dr. Okuley was a post-doctoral researcher at WSU. WSU had signed a contract with DuPont dating back to 1989. The contract which WSU signed with DuPont obligated WSU to assign its rights, under certain circumstances, in the invention of the first application to DuPont. Dr. Lightner and Dr. Okuley assigned their rights in the invention of the first application to DuPont.

Two continuation-in-part applications were filed disclosing additional experiments. Dr. Okuley was not involved in these experiments.

The first continuation-in-part application was filed via the PCT enlarging the original disclosure with these additional experiments and upgraded definitions. This PCT application was filed on October 15, 1993, and entered the national phase in the United States on October 7, 1994. This first continuation-in-part application bore Application No. 08/256,047 (Attorney Docket No. BB-1043-A).

U.S. Application No. 08/256,047 will be abandoned. Dr. Okuley and Dr. Lightner were named as co-inventors. DuPont requested that Dr. Okuley execute a standard form assignment (one not requiring the payment of a royalty to Dr. Okuley) conveying to DuPont his rights in this first continuation-in-part application. Dr. Okuley refused to execute the assignment provided by DuPont and has refused to do so unless DuPont agrees to pay him a royalty upon any commercial exploitation of any patent which may issued on the application.

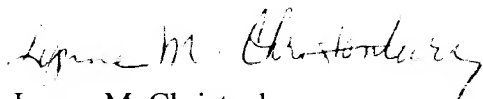
The second continuation-in-part application was a United States national application filed in June, 1994 claiming priority of the PCT application and the original application filed in November, 1992. This application bore Application No. 08/262,401 and was filed on June 20, 1994 and will be abandoned. This second continuation-in-part application expanded the scope of the original claims to cover additional DNA isolated in new experiments performed by DuPont scientists. Dr. Okuley was not involved in these new experiments. Dr. Okuley and Dr. Lightner were named as co-inventors. Again, Dr. Okuley refused to execute a standard form assignment requested by DuPont.

The instant application (Attorney Docket No. BB-1043-D) is a continuation of the continuation-in-part application filed in June, 1994 which claimed priority of the PCT case filed in October, 1993 and the first application filed in November, 1992.

DuPont sued Dr. Okuley in the Federal District Court for the Southern District of Ohio, *E. I. du Pont de Nemours and Company v. Dr. John Joseph Okuley*, Case No. C2 97-1205, seeking a declaratory judgment that (i) Dr. Okuley has no rights to, or interest in, any invention described in the BB-1043-A and BB-1043-B patent applications; (ii) Dr. Okuley has breached his contractual and common law duties to DuPont and WSU by refusing to execute an unconditional assignment of his rights and interest in the BB-1043-A and BB-1043-B patent applications; and (iii) DuPont is legally entitled to such an assignment from Dr. Okuley forthwith. In response to DuPont's suit, Dr. Okuley has challenged (i) the validity of the original assignment that he executed in connection with the first application; (ii) his obligation to execute an assignment in connection with the continuation-in-part applications and (iii) the propriety of joint inventorship, contending that he is the sole inventor.

It should be noted that Applicants' abandoned U. S. Application Nos. 08/262,401, (Attorney Docket No. BB-1043-B) filed on June 20, 1994, and 08/256,047 (Attorney Docket No. BB-1043-A), filed on October 7, 1994, in favor of continuing prosecution of the present application having Attorney Docket Number BB-1043 US NA DIV and copending application having Attorney Docket Number BB-1043-D. Thus, this disclosure is being made in connection with the prosecution of the present application and this disclosure was also made in connection with the prosecution of copending BB-1043-D. This disclosure has not been submitted previously in connection with the prosecution of any of the other aforementioned applications because they have been abandoned.

Respectfully submitted,



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Enclosures